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10/598,101

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Pascal Paganon

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EXAMINER

LAUER, CHRISTINA C

ART UNIT

PAPER NUMBER

3773

NOTIFICATION DATE

DELIVERY MODE

05/20/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-at@btlaw.com

## Office Action Summary

Application No.

10/598,101

Applicant(s)

PAGANON ET AL.

Examiner

CHRISTINA LAUER

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/29/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14 and 20, drawn to a surgical band.

Group II, claim(s) 15-19 and 21, drawn to a method of manufacturing a surgical band.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the groups having feature of a band comprising a pouch with an inner face and longitudinal slot for influencing the deformation of the inner wall when the strip forms a closed loop.

During a telephone conversation with Jason Bernstein on 4/25/11 a provisional election was made **without traverse** to prosecute the invention of group 1, claims 1-14 and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-19 and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11 recites the limitation "the cap" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, it is unclear what it meant by "an overall quarter-like appearance". The claim is unclear because the language does not specifically disclose what a quarter-like appearance is in reference to within the claim and is a relative term.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-10, 14, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Jakobsson et al. US 6102922.

Regarding claims 1, 14, Jakobsson et al. discloses a surgical band designed to be implanted in the body of a patient around a biological organ or organs (figure 1), comprising of a pouch or a tube for altering the flow area of said organ when it is clamped by the band, said band comprising:

a flexible strip (for example, 11 or 27) designed to be substantially closed at its two ends in order to form a closed loop (column 6, lines 23-28), said strip comprising an annular compression chamber designed to contain a filling fluid (column 3, lines 1-8); said chamber being defined by an internal wall (column 3, lines 6-8, element 19; or inner wall 31), lines designed to be in contact with the organ, such as a gastroplasty band around the stomach or esophagus, being clamped and a dorsal wall wherein said dorsal wall consists of a bead having an inner face situated opposite the chamber, said inner face has at least one longitudinal slot (figure 3, bulges) for influencing the deformation of the internal wall with a view to limiting the presence of surface irregularities in the area of the internal wall when the strip forms a closed loop (column 3, lines 24-34).

Regarding claim 2, Jakobsson et al. discloses wherein the internal wall comprises a membrane (for example, column 6, lines 33-34).

Regarding claims 3 and 20, Jakobsson et al. discloses wherein the chamber is a chamber having a volume that can be adjusted by injecting or withdrawing said filling fluid (column 3, lines 41-44).

Regarding claim 4, Jakobsson et al. discloses wherein the bead has a homogenous property and the longitudinal slot is arranged entirely within the bead (figure 3; column 3, lines 38-40).

Regarding claim 5, Jakobsson et al. discloses wherein the internal wall comprises a first elastomer material and the dorsal wall comprises a second elastomer material (column 4, line 4; column 6, lines 33-34).

Regarding claim 8, Jakobsson et al. discloses wherein the internal wall is made integral with the dorsal wall (figures 2, 3).

Regarding claim 9, Jakobsson et al. discloses wherein the innerface of the bead has a single longitudinal slot positioned substantially at the center of the face (between bulges; it is noted that the prior art must comprise one slot, not necessarily only one slot in the center or on the face).

Regarding claim 10, Jakobsson et al. discloses wherein the longitudinal slot has substantially rectangular shaped cross section (can be considered rectangular with rounded corners, figure 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakobsson et al. US 6102922.

Regarding claims 6 and 7, Jakobsson et al. discloses wherein the first and second materials are elastic, but not explicitly that they are identical with substantially identical hardness levels. It would have been obvious to one having ordinary skill in the art to modify Jakobsson et al. with the materials of ideal hardness levels for each portion of the device, as it is known within the general skill of a worker in the art to select a material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 11-13, Jakobsson et al. discloses wherein the strip is in the form of a solid tube having a substantially elliptical cross section, said tube being hollowed out so as to form both the chamber and the longitudinal slot (it is to be noted that this structure is disclosed in the prior art as claimed, and although does not explicitly disclose the process, it does not matter how the device is made, but only what the final product structure comprises), said chamber and slot communicating to form a single cavity (figure 3, for example). but does not explicitly disclose where in the cross sectional shape resembles that of a mushroom, whose stem is formed by the slot and the cap is formed by the chamber, wherein the chamber has a quarter-like or crescent-like appearance.

Jakobsson et al. discloses the claimed invention except for where in the cross sectional shape resembles that of a mushroom, whose stem is formed by the slot and the cap is formed by the chamber, wherein the chamber has a quarter-like or crescent-like appearance.



It would have been an obvious matter of design choice to modify Jakobsson et al. with the desired shape of a mushroom, since such a modification would have involved a mere change in the form or shape of a component. A change in form or shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1976). Further, Jakobsson et al. discloses where various configurations can be disclosed as desired (various number of slots within the device) and solves the same problem as the present invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINA LAUER whose telephone number is (571)270-5418. The examiner can normally be reached on Monday-Thursday 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. L./

Examiner, Art Unit 3773

/Darwin P. Erezon/

Primary Examiner, Art Unit 3773